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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/591,899 | 09/07/2006 | Masanori Somei | 1254-0323PUS1 | 7982 |
| 2292 7590 04/13/2011 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747 | | | | |
| EXAMINER PAGONAKIS, ANNA | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 1628 | | | | |
| NOTIFICATION DATE | | DELIVERY MODE | | |
| 04/13/2011 | | ELECTRONIC | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary

Application No.

10/591,899

Applicant(s)

SOMEI ET AL.

Examiner

ANNA PAGONAKIS

Art Unit

1628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-9 and 14-23 is/are pending in the application.
- 4a) Of the above claim(s) 6-9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4, 14, 16 and 23 is/are rejected.
- 7) ☒ Claim(s) 5, 15 and 17-22 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

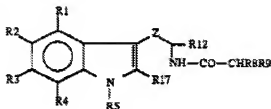
Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-940)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Applicant's amendment filed 1/26/2011 have been received and entered into the present application.

A reasonable and comprehensive search conducted by the Examiner determined that the prior art at the time of the present invention was such that it did not anticipate or render obvious the elected species. A search, however, did discover prior art that read on the claimed genus. Therefore, the prior art of the instant Office Action is drawn to the discovered species disclosed below. Specifically, the specie election is being expanded to the following compound:



where on the above formula R1 and R3 are each respectively halogen, R4, R5, R8, R9 and R12 are each respectively hydrogen, R2 is alkoxy, Z is CH2 and R17 is bromine.

Applicant's arguments filed 1/26/2011 have been fully considered. Rejections not reiterated from previous Office Actions are hereby withdrawn. The following rejections are either reiterated or newly applied. They constitute the complete set of rejections presently being applied to the instant application.

Status of Claims

Claims 4-9 and 14-23 are pending.

Claims 6-9 are withdrawn.

Claims 4-5 and 14-23 are currently under examination and the subject matter of the present Office Action.

Objection

Claims 5, 15 and 17-22 are objected to for being dependent from a rejected independent claim. It should be noted that examination at this point is solely drawn to the expanded specie election.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

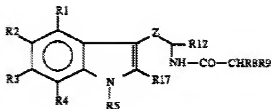
Claims 4, 14, 16 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fourtillan et al. (U.S. 5,763,471)

Determination of the scope and contents of the prior art

Fourtillan et al. teaches obvious variants of the instantly claimed compounds.

Ascertaining the differences between the instant claims and the prior art

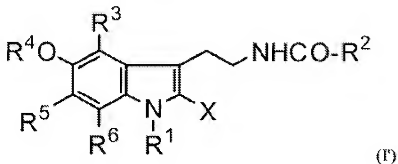
The following compound is taught by Fourtillan et al. (column 3, lines 45-66):



where on the above formula of Fourtillan et al. R1 and R3 are each respectively halogen, R4, R5, R8, R9 and R12 are each respectively hydrogen, R2 is alkoxy, Z is CH2 and R17 is bromine. The compounds can be used for the treatment of disorders associated with melatonin disorders in a pharmaceutical and cosmetic composition (abstract).

Resolving the level of ordinary skill in the pertinent art – Prima facie case of obviousness

The instant claims are drawn to the compound:



where on the above formula of claim 1, R₂ is a C₂ alkyl, R₁ and R₆ are each respectively hydrogen, R₃ and R₅ are each respectively halogen, R₄ is alkyl and X is bromine.

The compounds differ such that the compound of Fourtillan et al. teaches that a methyl group attached to the carbonyl:



while the instantly claimed compound requires a C₂ alkyl at R₂.

With regards to positional isomers, MPEP 2144.09.II. states, "Compounds which are position isomers (compounds having the same radicals in physically different positions on the same nucleus) or homologs (compounds differing regularly by the successive addition of the same chemical group, e.g., by -CH₂- groups, as is present in the instant case) are generally of sufficiently close structural similarity that there is a presumed expectation that such compounds possess similar properties. In re Wilder, 563 F.2d 457, 195USPQ 426 (CCPA 1977).

In positional isomerism, a functional group changes position on the chain or ring. As claimed, these two positional isomers have identical intended uses as well. As stated in In re Norris 179 F.2d 970, 84 U.S.P.Q. 458 (C.C.P.A. 1970), a novel useful compound that is isomeric with the prior art compound is unpatentable unless it possesses some unobvious or unexpected beneficial property not possessed by

the prior art compound. In other words, if the positional isomers of the instant application produced unexpected results that would not be obvious to one of ordinary skill in the art, they would be patentably distinct; however, there is no evidence of such results in the instant application.

One of ordinary skill would be motivated, from the disclosure in the prior art, to make the modifications required to arrive at the instant invention with reasonable expectation of success for obtaining a compound with the same utility. The motivation to make the change would be to make additional compound for the quoted purpose.

Thus, the instant claims are prima facie obvious.

Conclusion

No claim is found to be allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANNA PAGONAKIS whose telephone number is (571)270-3505. The examiner can normally be reached on Monday thru Thursday, 7am to 5pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brandon Fetterolf can be reached on 571-272-2919. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AP

/Brandon J Fetterolf/
Supervisory Patent Examiner, Art Unit 1628